

**REMARKS**

Claims 1, 20, 39-41 and 43-45 have been amended such that the claimed oily phase consists essentially of liquid oils. Support for these amendments exists, *inter alia*, at page 6, line 19 *et seq.* and page 11. Claims 1-10, 12, 13, 15-32 and 34-46 are currently pending, although claims 12, 13 and 30-32 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants intend to seek rejoinder of the withdrawn claims.

The Office Action rejected claims 1-10, 15-29 and 34-46 under 35 U.S.C. §103 as obvious over JP 09255529 ("JP '529") in combination with U.S. patent 5,326,484 ("Nakashima"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The claimed invention requires the oily phase to consist essentially of liquid oils. The primary reference, JP '529, neither teaches nor suggests this limitation. To the contrary, JP '529 teaches away from O/W emulsions in which the oily phase consists essentially of liquid oils.

Specifically, JP '529 states that 0.5-20% of a solid oily component must be present in its compositions. (See, "[Solution]" on p. 3/34 and par. [0021] on p. 16/34). In fact, JP '529 teaches that if less than 0.5% solid oily component is present, the resulting product is unacceptable. (See, par. [0021] on p. 16/34). Moreover, JP '529's comparative example 2 demonstrates that compositions containing an oily phase lacking solid fatty substances are unacceptable and, thus, that substantial amounts of solid fatty substances must be present. (See, par. [0052] on p. 27/34). Therefore, JP '529 teaches that the presence of substantial

amounts of solid fatty substances materially affects the compositions disclosed therein and requires that its compositions contain such substantial amounts of fatty substances.

In contrast, the claimed oily phase "consists essentially of" liquid oils. That is, the claimed oily phase cannot contain sufficient solid fatty substance to materially affect it. See, *PPG Industries v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998) (copy attached) ("consisting essentially of" language opens claims to unlisted ingredients that do not materially affect the basic and novel properties of the invention). Because JP '529 teaches that sufficient solid fatty substance must be present to materially affect the properties of the compositions disclosed therein, JP '529 actually teaches away from the claimed oily phase. One skilled in the art, following JP '529, would not be motivated to produce an O/W emulsion in which the fatty substances in the oily phase consist essentially of liquid oils. Rather, she would be motivated to produce an oily phase containing an amount of solid fatty substances that adversely affects the composition's characteristics.

Nakashima fails to compensate for JP '529's deficiencies: nothing in Nakashima would motivate one skilled in the art to modify JP '529, contrary to the teachings of JP '529, such that the fatty substances in the oily phase consist essentially of oils.

For this reason alone, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

Moreover, no motivation would exist to combine JP '529 and Nakashima with the expectation that a stable emulsion containing monodispersed globules would be obtained. JP '529 does not teach or suggest monodispersed globules. Also, as noted above, JP '529 teaches that a substantial amount of solid fatty substance must be present. There is no indication that

Application No. 09/555,523  
Reply to Office Action dated July 22, 2003

JP '529's oil phases containing substantial amounts of solid fatty substances could be subjected to Nakashima's methods or that, if subjected to such methods, JP '529's O/W emulsions would emerge stable and monodispersed. This is particularly true in view of the fact that Nakashima is virtually silent regarding what oils can be used in his methods. The only teaching Nakashima provides in this regard is in his examples directed to O/W emulsions where the oil phase is a non-solid oil, kerosene. (See, examples I and II directed to O/W emulsions at col. 9, line 50 and col. 11, line 11, respectively).

Given such a minimal disclosure regarding acceptable oils for use in his methods, Nakashima cannot be said to teach or suggest that his methods would have been obvious to use for any oil phase with the expectation that acceptable, stable, monodispersed compositions would be obtained, particularly oil phases containing a substantial amount of solid fatty substances.

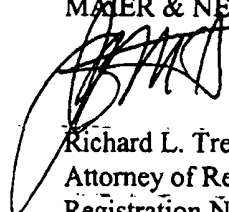
In view of the above, Applicants respectfully submit that the §103 rejection based upon JP '529 and Nakashima is improper and should be withdrawn.

Application No. 09/555,523  
Reply to Office Action dated July 22, 2003

Applicants respectfully submit that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number  
**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220